

Remarks/Arguments:

Claims 3-9 and 14 are pending in the above-identified application for consideration. By the present Amendment, claims 3-9 are amended; claims 1, 2, 12 and 13 are cancelled; and new claim 14 is presented for consideration. Claims 10 and 11 have been previously withdrawn from consideration.

Rejections of the Claims Under 35 U.S.C. § 112, First Paragraph

Pending claims 3-9 are rejected under 35 U.S.C. §112, first paragraph, for failing to comply with the written description requirement. Applicants respectfully disagree but amend the claims to expedite prosecution. In particular, Applicants amend pending claims 3-9 to remove recitations relating to a "computer processor" and "software instructions." Applicants reserve their right to present such limitations in the future and argue for their compliance with the written description requirement. Withdrawal of the rejections and favorable reconsideration of the claims are respectfully requested.

Rejections of Claims 1, 3, and 12 Under 35 U.S.C. § 103(a)

Claims 1, 3, and 12 are rejected under 35 U.S.C. § 103(a) for being unpatentable over WIPO International Publication No. WO 01/92050 of Yamanashi, U.S. Patent No. 5,989,739 to Zur Megede et al. ("Zur Megede"), U.S. Patent No. 6,797,418 to Nomura et al. ("Nomura"), and U.S. Application Publication No. 2002/0051899 of Keskula et al. ("Keskula"). By the present Amendment, Applicants amend claim 3 and cancel claims 1 and 12 to expedite prosecution. For the reasons discussed below, Applicants respectfully assert that claim 3 is not obvious in view of Yamanashi, Zur Megede, Nomura, and Keskula.

In particular, Applicants respectfully assert that neither Yamanashi, nor Zur Megede, nor Nomura, nor Keskula, nor their combination discloses or suggests the following features of claim 3:

... the electric power generation instructing means configured to decrease the electric power generated by the fuel cell at a rate depending on a change of the temperature of the fuel processor, wherein:

the electric power generation instructing means are configured to decrease the generated electric power at a first rate within a predetermined first limit while the temperature of the fuel processor is rising and at a second rate having no predetermined limit while the temperature of the fuel processor is not rising.

These features can be found in the originally filed application at page 17, line 10 - page 19, line 8 and originally filed claims 1 and 2. No new matter has been added.

1. Yamanashi Does not Disclose the Configuration of the "Electric Power Generation Instructing Means" Recited in Claim 3

The above-identified application describes various algorithms which an electric power generation instructing means is **configured to perform**. (See, e.g., Application, page 16, lines 12-15; page 22, lines 10-13; page 29, lines 17-20; and Figs. 2, 4, and 6.) Applicants respectfully assert that the control unit 300 of Yamanashi does not disclose or suggest all of the above-quoted features of claim 3 relating to the "electric power generation instructing means."

In a first embodiment of the fuel cell system of Yamanashi, a control unit 300 receives a signal 301 from a temperature sensor which detects a temperature of cooling water for a fuel cell 200, a signal 302 from a sensor that detects a position of an accelerator of the automobile, and a signal 303 corresponding to the vehicle's speed. (See Yamanashi, page 11, lines 6-12.) In this embodiment, Yamanashi does not describe decreasing generated electric power **"at a first rate within a predetermined first limit** while the temperature of the fuel processor is rising" (emphasis added). Further, Yamanashi does not describe decreasing generated electric power **"at a second rate having no predetermined limit** while the temperature of the fuel processor is not rising" (emphasis added). Yamanashi simply does not disclose first and second rates for decreasing generated electric power in this first embodiment. Yamanashi also does not disclose these rates in the fifth through eighth embodiments described therein. (See Yamanashi, page 16, lines 19-

25; page 18, lines 4-18; page 19, lines 15-35; and page 20, line 23 - page 21, line 8.) Thus, Applicants respectfully assert that Yamanashi does not disclose or suggest the above-quoted features of claim 3 relating to first and second rates.

The Office Action admits that Yamanashi does not disclose the features of claim 3 relating to decreasing the electric power depending on a change in the temperature of the fuel processor. (See Office Action, page 7, lines 7-13.) The Office Action cites to Nomura as disclosing these features. Applicants respectfully disagree.

The portion of Nomura cited in the Office Action describes a temperature detecting means 24 that is installed in a deriving conduit or device 41 "downstream of the reforming section to detect a **temperature of the deriving flow path or device.**" (See Nomura, col. 3, lines 19-23.) (Emphasis added.) As can be seen in FIG. 1 of Nomura, the temperature detecting means 24 detects the temperature of the conduit or device 41 that is downstream from a heat exchanger 7, which is downstream from another heat exchanger 5, which is downstream from a reforming section 4. The heat exchanger 5 cools the reformed gas output by the reforming section 4. (See Nomura, col. 7, lines 8-13.) The heat exchanger 7 cools the reformed gas that passes out of the heat exchanger 5 and through the CO removal section 6. (See Nomura, col. 7, lines 20-26.) **The temperature detecting means 24 detects the temperature of gases cooled by the heat exchanger 7; it does not detect the temperature of a fuel processor.** Thus, Applicants respectfully assert that the portions of Nomura relied upon in the Office Action do not disclose the above-quoted features of claim 3 relating to decreasing the electric power depending on a change in the temperature of the fuel processor.

The portions of Zur Megede and Keskula relied upon in the Office Action do not provide the material missing from Yamanashi and Nomura. Accordingly, Applicants respectfully assert that claim 3 is not obvious in view of Yamanashi, Nomura, Zur Megede, and Keskula. Withdrawal of the rejection of claim 3 and reconsideration and allowance of the claim are respectfully requested.

2. *The Functionality Performed by the "Electric Power Generation Instructing Means" is not Performed by a Human*

The Office Action asserts that the "figures provided are merely algorithms, and for example could be performed by a person getting data on a screen and manually operating valves in the correct process manner." (See Office Action, page 3, lines 11-13.) Applicants respectfully disagree.

Applicants direct the Examiner's attention to FIGS. 1 and 4 of the application and the description of these figures. FIG. 1 illustrates various components of a "fuel cell electricity-generating **device**." (See Application, page 13, line 24 - page 14, line 9.) (Emphasis added.) One of these components is an "electric power generation instructing means 5," which performs the features of the algorithm in FIG. 4 of the application. (See Application, page 13, line 24 - page 14, line 9 and page 22, line 10 et seq.) One of ordinary skill in the art would understand that the "electric power generation instructing means" is not a person as **a person is not part of a "device."** One of ordinary skill in the art, therefore, would understand that the steps of the algorithm in FIG. 4 are not performed by a person, as the Office Action argues.

Applicants also direct the Examiner's attention to the preamble of claim 3. The preamble recites that the claim is directed to a "fuel cell electricity-generating **device**." (Emphasis added.) The claim recites various components of the "device," including "an electric power generation instructing means." The claim recites features relating to the "electric power generation instructing means." Again, one of ordinary skill in the art would understand that the "electric power generation instructing means" is not a person as **a person is not part of a "device"** and that features of the "electric power generation instructing means" are not performed by a person. *In re Bernhart*, 417 F.2d 1395 (C.C.P.A. 1969) supports such an interpretation. Favorable consideration is respectfully requested.

3. *The Claims Do Not Merely Recite an Intended Use of the "Electric Power Generation Instructing Means"*

In a prior Office Action (see Office Action dated May 6, 2008), the Office provided the following remarks:

Applicant's arguments with respect to the independent and dependent claims are all directed to the fact that Yamanashi et al. does not teach a fuel cell

electricity-generating device with elements that are 'configured' to perform certain actions (i.e. decreasing the electric power generated depending on a decrease of load power to be supplied by the fuel cell (see p 8 of the remarks), [sic] etc.). **Namely, Applicant argues that using 'configured for' affects the claims in such a manner such that the actions that it is configured for is not functional language.** (See Office Action, May 6, 2008, page 9, Item 3.) (Emphasis added.)

The Office Action continues by arguing that Applicants apply "too narrow of a definition to 'configured for' language." (See Office Action, May 6, 2008, page 9, Item 3.) The Office Action argues that the fuel cell system of Yamanashi "is configured for performing the same actions [as Applicants' claimed invention] as it is structurally the same." (See Office Action, May 6, page 9, Item 3.) Applicants respectfully disagree.

By the present Amendment, Applicants amend the claims to recite "configured to" rather than re-introducing the language, "configured for," submitted in a previous Amendment. Applicants respectfully assert that "configured to" provides a structural difference over Yamanashi.

Random House Webster's Unabridged Dictionary (2nd Edition, 1997) (copy enclosed) defines "configure" as "to design or adapt to form a specific configuration or for some specific purpose" and "configuration" as "the relative disposition or arrangement of the parts or elements of a thing." So defined, "configure" relates to a designed relative disposition or arrangement of parts of a thing. This definition does not evoke an intended use, but instead a structural relationship. Thus, by including the recitation of "configured to" in the claims, the claims recite arrangements of parts of a thing in the "electric power generation instructing means," i.e., they recite structure. Because the control unit 300 in Yamanashi does not include such structure, as discussed above, it does not disclose all of the features of the "electric power generation instructing means" recited in claim 3.

Further, even if one were to interpret the claim language "configured to" as being functional language, an interpretation which Applicants dispute, Section

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2173.05(g) of the MPEP (entitled "Functional Limitations") provides that functional language is not necessarily improper:

A functional limitation is an attempt to define something by what it does, rather than by what it is (e.g., as evidenced by its specific structure or specific ingredients). There is nothing inherently wrong with defining some part of an invention in functional terms. Functional language does not, in and of itself, render a claim improper. In re Swinehart, 439 F.2d 210, 169 USPQ 226 (CCPA 1971).

Accordingly, Applicants respectfully assert that the claims recite patentable differences over Yamanashi and the other references relied upon in the Office Action mailed Sept. 24, 2008, as discussed above.

New Claim 14

By the present amendment, Applicants submit a new claim 14 for consideration. For reasons similar to those presented above, Applicants respectfully assert that the references relied upon in the rejection of claim 3 do not disclose or suggest all of the features of claim 14 or claims 4-9 depending therefrom, particularly those relating to the "first power limitation mode" and the "second power limitation mode." Favorable consideration is respectfully requested.

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Conclusion

In view of the foregoing remarks and amendments, Applicants respectfully assert that the claims are in condition for allowance and respectfully request early notification to that effect.

Respectfully submitted,



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Enclosure: Copy of Selection from Random House Webster's
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PZ/nm

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